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Claims 1-27 are currently pending in the subject application and are presently under consideration. A new listing of the claims is at pages 2-5 of the Reply. Claims 1-2, 5-13, 15-17, 19-23 and 25-27 have been amended to more clearly recite the invention. Claims 3, 4, 14 and 24 have been canceled.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to Claims 2-9, 11-17, 20, 22 and 27

Claims 2-9, 11-17, 20, 22 and 27 are objected to because of informalities. The informalities have been changed in accordance with the Examiner's request. Accordingly, applicant's representative requests that the Examiner withdraw the objection.

II. Rejection of Claims 1-20 under 35 U.S.C. §112, first paragraph

Claims 1-20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, by claiming subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 10 and 19 have been amended to more clearly recite the invention. Thus, applicant's representative requests that the Examiner withdraw the rejection.

III. Rejection of Claims 1-18 and 21-27 under 35 U.S.C. §112, second paragraph

Claims 1-18 and 21-27 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the application regards as the invention.

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. The claims have been amended to more clearly emphasize the invention. Claims 1 and 10 have been amended to recite "an edible material surrounded by the shell..."

Claims 2, 5, 8, 13, 23 and 24 have been amended to use the alternative form in combination of the terms "comprise" or "include", or plural forms thereof.

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Claim 11 has been amended to more clearly recite the invention, to wit, "...mating pieces that are bonded together to enclose the edible material."

Claim 15 has been amended to more clearly recite the invention.

Claim 21 has been amended to clarify the relationship between formation of the shell and insertion of the edible material.

Accordingly, it is requested that this rejection be withdrawn for independent claims 1, 10 and 21, and the claims that depend therefrom.

IV. Rejection of Claims 1, 3, 5, 10-13, 15, 17, 18, 21-23, 26 and 27 under 35 U.S.C. §102(b)

Claims 1, 3, 5, 10-13, 15, 17, 18, 21-23, 26 and 27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Brekau (DE-29703253).

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Brekau neither teaches nor suggests each and every element of the subject claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Brekau teaches a cat plaything in the form of a ball containing food comprising two joined half-shells, which themselves are edible or inedible, and with suitable provisions for a claw grip to provide the cat with object suiting its natural hunting and play instincts. A felt or woolen surface may be used, capable of being held by the claws, and putting up some resistance, and on opening, the cat gets its reward. The edible material with holes for grip may form the shell halves.

Contrariwise, as amended, independent claim 1 includes the limitations recited in dependent claims 3 and 4. More specifically, "...the edible material includes catnip..."

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Brekau does not teach using catnip. Accordingly, it is respectfully requested that this rejection be withdrawn, and that claims 2 and 5-9 that depend therefrom also be allowed.

Independent claim 10, as amended, recites, in part, "... the edible material comprises a combination of different edible components..." Brekau does not teach such a limitation. Accordingly, it is respectfully submitted that claim 10 and claims 11-13 and 15-18 that depend therefrom be allowed.

Independent claim 21, as amended, recites in part "...mixing the edible material into a substantially homogeneous mixture of at least one of an inducement, a nutriment, or a treatment;" Brekau does not teach such a limitation. Accordingly, it is respectfully submitted that claim 21 and claims 22-23 and 25-27 that depend therefrom be allowed.

V. Rejection of Claims 1-5, 10, 14, 16 and 18 under 35 U.S.C. §102(b)

Claims 1-5, 10, 14, 16 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Smith (US Patent No. 1,022,113).

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Smith neither teaches nor suggests each and every element of the subject claimed invention.

Smith teaches a catnip ball which can be played with by a cat without making an appreciable noise and without any danger of injuring furniture, and which is made so that the catnip contained therein cannot be distributed over the floor. The ball is made partially or entirely of a catnip compound. The compound can be composed of various ingredients besides catnip, preferably using some neutral or inert material or materials that give body to the ball and act as a binder to retain the catnip in mass, but not destroy or deteriorate the odor. Smith teaches a preferred catnip compound that includes wood pulp or paper pulp, and that it may be desirable to add glue, cement or other cementitious substance to the compound.

In contrast, claim 1 recites that "... the toy is consumable in its entirety." Smith neither teaches nor suggests the recited limitation. Moreover, Smith teaches away from the toy being entirely consumable by the use of products in the catnip compound that are not normally considered edible products such as, for example, wood pulp, paper pulp, glue, cement or the like. Accordingly, it is respectfully submitted that this rejection for claim 1 should be withdrawn and, that claims 2 and 5-9 that depend therefrom be allowed.

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Amended claim 10 recites that "... the edible material comprises a combination of different edible components..." and that "the toy is consumable in its entirety." Smith fails to teach each limitation separately or in combination. Accordingly, it is respectfully submitted that claim 10 and claims 11-13 and 15-18 that depend therefrom be allowed.

VI. Rejection of Claims 2, 4, 9, 14, 16 and 19-20 under 35 U.S.C. §102(b)

Claims 2, 4, 9, 14, 16 and 19-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Denesuk et al. (US Patent No. 6,178,922).

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Denesuk neither teaches nor suggests each and every element of the subject claimed invention.

Denesuk teaches a mastication article for a domestic animal comprising tough chew-resistant material defining a shape in the form of a small article for enticing or being retrieved by a domestic animal, and an effective amount of microbe-inhibiting agent applied to or incorporated in the material. The mastication articles may be fabricated in various shapes, designs, and styles. A process for applying the microbe-inhibiting agent to the material for forming the mastication article is disclosed. Application methods include spraying and soaking the article, and incorporating the agent within a resin or material for forming the article. The article can be digestible in whole or in part.

In contrast, claim 1 recites, in part, "a shell..." and "an edible material surrounded by the shell..." Denesuk does not teach a shell or the edible material surrounded by the shell, but the application of microbe-inhibiting agent applied to or incorporated in the material. Moreover, the same argument applies to both claims 10 and 19. Thus, it is submitted that this rejection be withdrawn and that claims 2, 9, 16 and 20 be allowed.

VII. Rejection of Claims 6, 7 and 9 under 35 U.S.C. §102(b)

Claims 6, 7 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Fisher (US Patent No. 4,260,635).

It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Fisher neither teaches nor suggests each and every element of the subject claimed invention.

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Fisher teaches a simultaneously compacted, shaped, molded and unitized, self-contained, unit-integral, chew-resistant animal food system product containing animal food and structure-supporting fibers, preferably in a fibrous form, in an amount sufficient to make said product chew-resistant, self-contained and unit-integral and to enable it to be and remain in its compacted, shaped and molded form. The product contains sufficient structure-supporting fibers to yield a chew-resistant product. The structure-supporting fibers are animal safely digestible structure-supporting fibers, such as collagen, animal safely indigestible structure-supporting fibers, such as cellulosic materials, or a mixture of animal safely digestible structure-supporting fibers and animal safely indigestible structure-supporting fibers, such as a mixture of collagen and cellulosic materials. Illustrative food components are those animal foods currently used and known and are preferably in a dry, shelf-stable form such as dried meats, dried fish, fish meal, fish flour, cereals, fruits, etc., with or without food additives or supplements such as vitamins, minerals, medicinals, etc., for example chemicals, enzymes, etc., capable of removing plaque or tartar from the animal's teeth, etc. The products are focused for use by dogs, and the illustrations are of dog bones.

In contrast, claim 1, as amended "...facilitates stimulation of a cat..." Moreover, "...the shape facilitates prolonged motion of the toy when the toy is set in motion." Fisher neither teaches nor suggests each and every element of the subject claimed invention. Accordingly, it is respectfully submitted that this rejection be withdrawn and that claims 6, 7 and 9 be allowed.

VIII. Rejection of Claim 8 under 35 U.S.C. §103(a)

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Markham et al. (US Patent No. 5,947,061).

Applicant's representative respectfully requests that Examiner withdraw the rejection for at least the following reasons. Neither Brekau nor Markham, alone or in combination, teach or suggest applicant's invention as recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner appears to indicate that Brekau teaches a toy that can include projections on the exterior. Neither does Brekau teach, suggest, nor show this. Claim 8 depends from amended claim 1. Claim 1, as amended "...facilitates stimulation of a cat..." Moreover, Markham does not teach or suggest a pet toy for cats. Thus, Markham fails to make up for the deficiencies in Brekau. Hence, there is no motivation to combine the references, and it would not have been obvious to one skilled in the art to do so. Thus, it is respectfully submitted that this rejection be withdrawn.

IX. Rejection of Claims 18, 24 and 25 under 35 U.S.C. §103(a)

Claim 18, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brekau in view of Smith.

Applicant's representative respectfully requests that Examiner withdraw the rejection for at least the following reasons. Neither Brekau nor Smith, alone or in combination, teach or suggest applicant's invention as recited in the subject claims.

Claims 10 and 21 have been amended to include limitations which the references of Brekau and Smith, alone or in combination fail to render obvious. Thus, it is respectfully submitted that claims 18, 24 and 25 be allowed.

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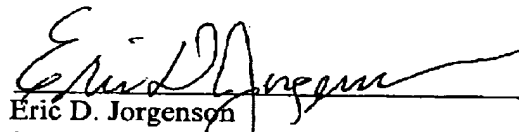
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicant's undersigned representative at the telephone number below.

In the event any additional fees may be due, the Commissioner is authorized to charge such fees to Deposit Account No. 50-3663 [BBUCP101USA]

Respectfully submitted,


Eric D. Jorgenson
Reg. No. 46,002

Law Office of Eric D. Jorgenson, Esq.
1457 King Road
Hinckley, Ohio 44233
Telephone (216) 225-4169
Facsimile (330) 278-3135